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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,605	03/04/2002	Randy Britton	020375-005800US	7661
20350 7590 04/01/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
NGUYEN, NGA B				
ART UNIT		PAPER NUMBER		
3692				
MAIL DATE		DELIVERY MODE		
04/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,605

Applicant(s)

BRITTON ET AL.

Examiner

Nga B. Nguyen

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 22-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15, 2009 has been entered.
2. Claims 19 and 22-35 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 19 and 22-35 have been fully considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 22 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 22 and 32, the "if" statement renders the claim indefinite because it connotes optional language whereby the limitation potentially and alternative is not required to perform the limitation.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 19 and 22-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 19 and 22-35 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a

particular machine. Thus, claims 19 and 22-35 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19 and 22-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Buchanan et al (hereinafter Buchanan), U.S. Patent No. 5,950,179, in view of Lent et al (hereinafter Lent), U.S. Patent No. 6,324,524, and further in view of Levake et al (hereinafter Levake), U.S. Patent Application Publication No. 2002/0156727.

Regarding to claim 19, Buchanan discloses a method implemented within a computer system for managing newly opened credit accounts for fraudulent activities, wherein the new credit accounts are fully established, enable a first set of fraud monitoring and prevention measures for the accounts, the method, comprising:

approving and opening a new credit account at the computer system (*column 3, lines 25-30, the account is approved and an advanced credit card is printed and issued*

to the new customer); and

upon opening the new credit account, applying a second, separate set of fraud prevention measures in the form of restrictions to the new credit account, the second set of restrictions being designed to focus on a transaction incurred with the new credit account and minimize fraudulent activities until the credit account is fully established (*column 3, lines 30-67, the advanced credit account required the customer to make secured deposit into customer's saving account for sufficient period of time in order to make the advanced credit account fulfilled; column 5, line 60-column 6, line 5*);

enabling the first set of fraud monitoring and prevention measures when the account is fully established (*column 5, lines 9-25, the tracking system may also classify the account as closed when the account is extremely delinquent, is bankrupt; the account may also be closed by reason of a default, such as a failure by the customer to pay the minimum balance on the accumulated charges on the credit card*).

Buchanan does not disclose approving and opening a new credit account in real-time, so that the account is available immediately thereafter for use in conducting transactions. However, Lent discloses approving and opening in real-time, so that the account is available immediately thereafter for use in conducting transactions (*column 6, lines 10-15*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Buchanan's to incorporate the feature taught by Lent's above for the purpose of providing time consuming for the consumer when requesting a new credit account because the approval is done in real-time.

Buchanan does not disclose executing the transaction batch process at the computer. However, Levake discloses executing the transaction batch process at the

computer (*paragraphs [0084]-[0088], executing batch process for credit card transactions*). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Buchanan's to adopt the features taught by Levake above for the purpose of providing more sufficiency in monitoring and tracking credit card account.

Regarding to claim 22, Buchanan further discloses if a restriction within the set of restrictions is violated, denying an authorization to use the new credit account (column 6, lines 62-67).

Regarding to claim 23, Buchanan further discloses wherein the set of restrictions is provided by an issuer of the new credit account (column 3, lines 1-5).

Regarding to claim 24, Buchanan further discloses wherein the set of restrictions includes a limit on allowable transaction amount for each individual transaction incurred in connection with the new credit account (column 6, lines 62-67)

Regarding to claims 25-26, Buchanan does not disclose the allowable transaction amount is limited to a percentage of available credit assigned for the new credit account and wherein the set of restrictions includes a limit on type of transaction that is allowable under the new credit account. However, the allowable transaction amount is limited to a percentage of available credit assigned for the new credit account and wherein the set of restrictions includes a limit on type of transaction that is allowable under the new credit account are well known in the art of processing and tracking a credit card account. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Buchanan's to incorporate the well-

known features above for the purpose of eliminating the risk for approving a credit card account.

Claims 27 -35 contain similar limitations found in claims 19-26 above, therefore, are rejected by the same rationale.

Conclusion

10. Claims **19 and 22-35** are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3692

March 23, 2009